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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,740	11/20/2001	Pekka Juhana Pihlaja	04770.00028	8949
22907	7590	08/09/2004	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			TRAN, HENRY N	
			ART UNIT	PAPER NUMBER
			2674	7

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,740

Applicant(s)

PIHLAJA, PEKKA JUHANA

Examiner

HENRY N TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 30, 32, 33, 36-45, 47, 49-51 and 53-68 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-27, 40-45, 47, 49-51, 53-56 and 63-68 is/are allowed.
6) ☒ Claim(s) 28, 30, 32, 33, 36-39 and 57- 62 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The applicant's amendment received 5/10/04 (Paper No. 6) has been entered. Claims 1-28, 30, 32, 33, 36-45, 47, 49-51 and 53-68 remain pending in this application.
2. Applicant's arguments, see pages 14-18 of the above-identified amendment, with respect to the rejections of claims 1-10, 18, 22-34, 36-42, 44-46, 48-51 and 53-56 as recited in the prior Office action mailed 2/26/04 (Paper No. 5) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Smith et al (Pub. No.: US 2002/0158838 A1) and Brisebois et al (Pub. No.: US 2001/0043189 A1).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 19 and 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 19, the claim term "The mobile device" recited in line 1 renders the claim indefinite. For the purpose of this Office action, the "The mobile device" is changed to --The portable device--.

Regarding claim 20, the claim term "the received input" recited in lines 2-3 renders the claim indefinite. For the purpose of this Office action, the "the received input" is changed to --the input--.

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Regarding claim 21, the claim term “the received input” recited in line 2 renders the claim indefinite. For the purpose of this Office action, the “the received input” is changed to --the input--.

Regarding claim 22, the claim term “the selectable icon input” recited in lines 5-6 renders the claim indefinite. For the purpose of this Office action, the “the selectable icon input” is changed to --the selectable icon is input--.

Claim Rejections - 35 USC § 102

5. (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 30 and 57-61 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith et al (U.S. Pub. No. US 2002/0158838 A1).

Smith et al teach a method for selecting items on a display screen 106 of an electronic device, comprising the steps of: detecting movement of a finger across touchpads 102 disposed around perimeters 110 of the visible display screen 106, wherein the touchpads 102 are linear input touch-strips for receiving x-axis, y-axis, and z-axis or scrolling/zooming inputs for moving a display element, e.g., a pointer, over corresponding content, e.g., on-screen menus, see Figs. 2 and 3, paragraphs 23, 30, 39 and 42. Smith et al touchpads 102 comprising a plurality of touch-strip portions, which are read on the claimed a first and a second touch-sensitive input areas, for detecting movements of a finger for determining a display screen x and y coordinates identified by the pointer or the point of contact, or for scrolling or zooming or panning a displayed image, see paragraphs 6 and 7.

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7. Claims 28, 32, 33 and 36-38 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smith et al (U.S. Pub. No. US 2002/0158838 A1).

Claims 28, 32, 33 and 36-38 comprise claimed method steps of the claims 30 and 57-61 discussed above. The touchpad 102 is a capacitive, resistive, semi conductive or optical sensor touchpad, see paragraphs 8 and 9, which is capable of resistance to sound interference. Claims 28, 32, 33 and 36-38 are therefore rejected.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 39 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (U.S. Pub. No. US 2002/0158838 A1) in view of Brisebois et al (U.S. Pub. No. US 2001/0043189 A1).

Smith et al teach generally all except for the step of highlighting the corresponding content. Brisebois et al teach an active edge input device and a method step of highlighting a displayed item, see Fig. 4a. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the method step of highlighting as taught by Brisebois et al in the Smith et al method because this would provide an effective and easy to use means for selecting desired functions depicted within a display screen. Claims 39 and 62 are dependent upon the dependent claims 36 and 59,

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respectively; and are therefore rejected on the same reasons set forth in claims 36 and 59, and by the reasons discussed above.

Allowable Subject Matter

10. Claims 1-27, 40-45, 47, 49-51, 53-56 and 63-68 are allowed.

Response to Arguments

11. Applicant's arguments with respect to claims 1-10, 18, 22-34, 36-42, 44-46, 48-51 and 53-56 have been considered but are moot in view of the new grounds of rejection.

12. The examiner has considered all the IDS References submitted on 12/19/01 (Paper No. 4). The corrected copy of the list of the initialed references has been faxed to applicant's attorney on 7/30/04.

13. The proposed supplemental amendments faxed to the examiner on 7/29/04 and 8/2/04 as the results of the telephone conversations with applicant's attorney, Mr. Ross A. Dannenberg, Reg. No. 49,024, have been carefully considered. However, they did not place the application in condition for allowance due to the teachings provided in the newly found references recited in this Office action; and the proposed supplemental amendments have been placed in the file record.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N TRAN whose telephone number is 703-308-8410. The examiner can normally be reached on M-F 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A HJERPE can be reached on 703-305-4709. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Henry N. Tran

HENRY N TRAN
Primary Examiner
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8/5/04